

Addendum 1

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CONFIRMATION

18th September 2008

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Dear Sirs,

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Opposition to European Patent No. 1628766
In the name of Dow Global Technologies Inc.
By BASF Aktiengesellschaft

We write in response to the summons to oral proceedings issued by the Opposition Division on 27th May 2008.

The undersigned representative will attend the oral proceedings and will speak English. We request interpretation from any other language spoken.

We enclose herewith a new first auxiliary request and second auxiliary request. The main request of the patentee is to maintain the patent as granted. In the first auxiliary request, Claim 19 has been deleted and previous Claim 20 renumbered as Claim 19.

The second auxiliary request corresponds to the previous first auxiliary request. In the second auxiliary request, Claims 18 to 20 have been deleted.

In the summons to oral proceedings, the Opposition Division have taken the view that Claim 19 is not novel over the disclosure of D1. According to section 2 of the summons, the Opposition Division are of the view that D1 unambiguously identifies two groups of particles in the bimodal mixture. The summons goes on to say that as the particles have been prepared and identified, the subject matter of Claim 19 lacks novelty. We respectfully submit that the Opposition Division are not correct in this assertion.

Claim 19 is directed towards "a metal cyanide catalyst in the form of particles having an average particle size of from 5 to 500nm". The scope of the claim is therefore restricted to a catalyst in which the average particle size of all of the particles of the catalyst is from 5 to 500nm. As both the Opponent and the Opposition Division have correctly identified, D1 discloses a bimodal mixture of particles in which the group of smaller particles have a size within the range of 100 to 500nm.

However, in the disclosure of D1, this group of smaller particles is combined with a group of larger particles which have a significantly larger particle size, such that the total average particle size is significantly larger than 500nm. Neither the Opponent nor the Opposition Division appear to disagree with our assertion that the mixture of particles has an average particle size which is greater than 500nm.

A significant number of cases of the Board of Appeal, including T465/92 and T511/92, have held that in order for an invention to lack novelty over the prior art, its subject matter must be clearly and directly derivable from the prior art document. All of its features must be known from the prior art document. Therefore, in order for D1 to be a novelty destroying document, it must disclose a catalyst composition in which the particles have an average size of from 5 to 500nm. It is not sufficient to disclose a mixture of particles of which only some of the particles fulfil this requirement. Although the reader of D1 can mentally separate the two sets of particles from each other, should he have the motivation to do so, this cannot be considered to be a disclosure of such a separation. D1 does not suggest at any stage that the two sets of particles should, or even could, be separated.

The Opposition Division state that the physical means for separating particles was available at the filing date of the patent. However, this is of no relevance. If D1 itself does not refer to the separation of the smaller particles from the larger particles, then it cannot be considered to be a disclosure of a composition consisting of only the smaller particles.

The Opposition Division specifically refer to case G1/02 and correlated decisions as supporting its opinion. G1/02 is a decision relating to the powers of a formalities officer and is not connected to the present case. We presume that the Opposition Division intended to refer to G1/92, which decided that *a chemical composition of a product is state of the art when the product as such is available to the public and can be analysed and reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition* (see headnote). This case appears to tie in with the arguments that the Opposition Division has proposed. However, this case, and any correlated decisions, are entirely irrelevant to this opposition. There is a very clear difference which must be drawn between a prior art product which is available to the public and a published prior art document. The case law for a publicly disclosed product cannot be read directly on to a published reference. Therefore, for the consideration of novelty, the disclosure of document D1 can only be taken to be the subject matter disclosed in that document either explicitly or implicitly and cannot be extended to cover known means of separating particles unless there is a disclosure of separation in D1.

We offer by way of Example the comparable situation of enantiomeric compounds. It is common knowledge that a racemic mixture contains a mixture of at least two enantiomers. Methods of separating the enantiomers are well known to the skilled person. Based on the logic of the

Opponent, a disclosure of a racemic mixture is novelty destroying for an isolated enantiomer, as the mixture unambiguously discloses both enantiomers. However, it is well decided case law, such as in case T296/87 that the description of racemates did not anticipate the novelty of the enantiomer. That methods exist to separate the racemate was something that should only be considered with respect to inventive step.

By analogy, Claim 19 of the opposed patent is also novel over the disclosure of D1. The disclosure of a mixture of large and small particles does not anticipate the novelty of a composition containing only small particles. In so far as methods of separating the particles from each other was available at the filing date of the opposed patent, these should only be considered in relation to inventive step.

Accordingly, we submit that the subject matter of Claim 19 is, in fact, novel over the disclosure of D1.

Inventive Step

The Opposition Division have stated in the summons that Claims 18 and 20 are both novel and inventive over the disclosure of D1 and or D2. We concur with this statement.

In addition, for the reasons given above, Claim 19 is also novel over D1. Claim 19 is also inventive for the same reasons as for Claims 18 and 20.

As discussed in detail in our letter of 2nd April 2008, Claim 19 differs from D1 in that it requires the presence of a catalyst having an average particle size which is from 5 to 500nm. As discussed above, the average particle size of the catalyst described in D1 is significantly larger as the small particles cannot be considered to be separate from the large particles in the composition.

The technical effect of the small average particle size is to provide a catalyst which more efficiently catalyzes the EO-capping reaction and efficiently polymerizes propylene oxide as well (see paragraph 5 of the opposed patent).

The problem to be solved starting from D1 is therefore to provide a catalyst which catalyzes the EO-capping reaction more efficiently.

The solution to this problem is to use a catalyst with an average particle size of 5 to 500 nm. This solution cannot be obvious based on D1 as D1 does not discuss EO capping. Moreover, D1 does not teach the use of a low average particle size. Rather it teaches the use of a catalyst having a bimodal distribution including some small particles and some large particles. Therefore, there is nothing in D1 which would teach the skilled person to even seek to solve the problem of the opposed patent, much less solve it in the manner required by the present invention.

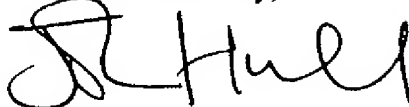
D2 does mention in passing that a block can be added on the end of the polyol. However, D2 is entirely silent about particle size. Neither of the documents cited by the Opponent teach the use of particles with an average size of from 5 to 500nm. Based on the disclosure of these documents, the subject matter of Claim 19 cannot be obvious.

For the same reasons, Claims 18 and 20 are not obvious over D1 and/or D2 either.

We note that the Opponent has not supplied any further documentation with its final submissions which further support its argument of lack of inventiveness. Given that the Opponent has had sufficient time to file such documentation, we hereby request that any documents filed on the day of the Oral Proceedings or later than the deadline for final submissions be refused as being late filed.

Accordingly, we request that the patent be maintained according to the main request or the first or second auxiliary requests.

Yours faithfully,

A handwritten signature in black ink, appearing to read 'J. Hull', written over a horizontal line.

John P. Hull

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